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**AUG 27 2004**

**OFFICE OF PETITIONS**

In re Application :  
James Chen :  
Application No. 09/905,501 : DECISION ON APPLICATION  
Filed: July 13, 2001 : FOR  
Attorney Docket No. 25886-0055B : PATENT TERM ADJUSTMENT  
:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 CFR 1.705(b)," filed March 10, 2004. Applicant requests that the initial Determination of Patent Term Adjustment under 35 U.S.C. 154(b) be corrected from two hundred ninety-two (292) days to three hundred ninety-five (395) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **three hundred twenty-seven (327)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On December 18, 2003, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicant was advised that the patent term adjustment to date is 292 days. Applicant timely filed the instant request for reconsideration of the patent term adjustment along with payment of the fee set forth in 37 CFR 1.18(e)<sup>1</sup>. Applicant requests correction of the patent term adjustment to 395 days.

First, of all, applicant asserts that the application is entitled to a patent term adjustment of 461, rather than 411 days, for Office delay in mailing a first Office action pursuant to 37 CFR § 1.703(a)(1). Applicant contends that the period under § 1.703(a)(1) should be calculated using the date of mailing of a corrected notice of allowance.

Secondly, applicant requests that the reduction of 119 days for applicant delay in responding to the Notice to File Missing Parts

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<sup>1</sup> PALM records indicate that the Issue Fee was received March 16, 2004.

of Application be decreased to 66 days. In part, applicant states that this reduction should be corrected to 84 days on the basis that their response was received in the Office on February 19, 2002, not March 26, 2002 (the date PAIR notes "Application is Now Complete"). In support thereof, applicant submits a copy of their itemized return postcard date-stamped February 19, 2002. Furthermore, applicant requests reinstatement of 18 days of this reduction on the basis that receipt of the response was delayed due to the USPS mail situation at that time.

Office records support a conclusion that the patent issuing from the application is not subject to a terminal disclaimer.

#### OPINION

The period of adjustment of 411 days pursuant to § 1.703(a)(1) has been reviewed and found to be correct. The Office mailed a notice of allowance under 35 U.S.C. 151 on October 29, 2003. A corrected notice of allowance was mailed on December 18, 2003. Applicant states that the corrected notice was mailed because, as a matter of record, the original notice was incomplete and never received by applicant. The application papers present in the application file are the Official record of the papers mailed and received in an application. A review of the copy of the notice mailed October 29, 2003, of record in the application indicates that a complete notice of allowance was mailed. However, due to non-receipt of the notice, it was re-mailed on December 18, 2003.

In this case, the subsequent mailing of another notice of allowance does not alter the date used in calculation of the period of adjustment. The record reveals both notices were mailed to the correspondence address of record. However, the notice was not received by applicant. Thus, the notice was re-mailed and the period for response restarted. It has not been shown that the re-mailing was due to any error on the part of the Office in mailing the first notice of allowance to applicant. Thus, the re-mailing of the notice of allowance did not constitute a delay by the Office in the issuance of the patent within the meaning of 35 U.S.C. 154(b).

However, the period of reduction of 119 days has been reviewed and found to be incorrect. A review of the application file reveals that applicant's complete response to the Notice to File Missing Parts of Application mailed August 27, 2001, is of record in the application with a date of receipt by the Office of February 19, 2002. This was outside of the three-month period under 37 CFR 1.704(b), but not by 119 days. Applicant should have been assessed a delay of 84 days, counting the number of days in the period beginning on the day after the date that is three months after the date of mailing of the notice, November 28, 2001, and ending on the date the reply was filed, February 19, 2002.

As to applicant's request to reinstate 18 days of delay, it is concluded that reinstatement is not appropriate. Applicant's response received February 19, 2002 bears a certificate of mailing dated January 28, 2002. The Office's policy with respect to reinstatement of patent term adjustment due to the mail delays of that period is set forth in an OG Notice dated January 15, 2002 (1254 OG 92). Such relief was expressly limited to replies

"mailed on or after October 13, 2001 and no later than December 1, 2001 (as shown on a certificate of mailing under 37 CFR 1.8)."

CONCLUSION

In view thereof, the petition is GRANTED to the extent indicated.

The patent term adjustment at the time of the mailing of the notice of allowance is **327** days.

Submission of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged.

The application is being forwarded to the Office of Patent Publication for issuance of the application.

Telephone inquiries regarding this matter should be directed to Senior Petitions Attorney Nancy Johnson at (703) 305-0309.

*Karin A. Ferriter*  
*for*

Karin Ferriter  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy

Enclosure: Copy of REVISED PAIR screen